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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,936	12/05/2001	Herman Chien	83531-322	9281
22504	7590	09/04/2007	EXAMINER SAMS, MATTHEW C	
DAVIS WRIGHT TREMAINE, LLP 1201 Third Avenue, Suite 2200 SEATTLE, WA 98101-3045			ART UNIT 2617	PAPER NUMBER
		MAIL DATE 09/04/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/006,936	CHIEN, HERMAN
	Examiner Matthew C. Sams	Art Unit 2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 18 June 2007.
- 2a)  This action is **FINAL**.                            2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 4-8, 10, 11, 14-28 and 30-33 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 4-8, 10, 11, 14-28 and 30-33 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on 6/18/2007.
2. Claims 29 and 34 have been canceled.

### ***Response to Arguments***

3. Applicant's arguments filed 6/18/2007 have been fully considered but they are not persuasive.
4. In response to the applicant's argument that in system of Peck "the dual-mode terminal (24) does not transmit the SIM-based ESN" (Page 9), the examiner disagrees.

The applicant has pointed to the transmission of "terminal-based ESN" which corresponds to the process prior to Peck's invention. Peck clearly teaches adding a "SIM-based ESN" to be stored in the Customer Service Profile (Col. 7 line 67 through Col. 8 line 8) which in turn means the dual-mode terminal is transmitting the SIM-based ESN in Fig. 4 Word C. (Col. 7 lines 36-45 and Col. 10 lines 20-25)

5. In response to the applicant's argument that the AUTHR "is not properly characterized as a user identifier because it is merely a keyed version of the terminal based ESN" (Page 9), the examiner disagrees.

The examiner would like to note that the claim only states the "user identifier is associated with a serial number that, at least in part, is assigned to the SIM by a manufacturer of the SIM". The examiner is correlating Peck's AUTHR value, which is associated with the SIM-based electronic serial number (ESN) (Col. 7 lines 36-45 and

Col. 10 lines 20-25), as the user identifier. Therefore, the broad claim limitations have been met within Peck's disclosure.

6. In response to the applicant's argument regarding claims 7, 8 and 27 (Page 10), the examiner disagrees.

Peck clearly teaches transmitting both the MIN and SIM-based ESN to the network. (Col. 10 lines 5 & 20-25 *i.e.* Claim 8 & 10)

7. In response to the applicant's argument regarding "teaching away" (Page 11), the examiner disagrees.

Peck clearly teaches "transmitting a SIM-based ESN for performing a key based authentication in the first network" (Claim 10), which clearly meets the applicant's broad claim limitation of a "user identifier is based, **at least in part**, on a serial number of a SIM".

8. The rejections to claims 10, 11 and 14-25 are maintained in view of the further explanation above.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 4-8, 27, 28 and 30-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Peck (US-6,606,491).

Regarding claim 4, Peck teaches a communication device (Fig. 1 [24] and Fig. 2 comprising a register configured to store a user identifier (Col. 3 lines 13-15 SIM-based ESN), a transmitter configured to transmit the user identifier to a network (Fig. 2 [54] and Col. 3 lines 51-57) and a SIM card (Fig. 2 [90]) wherein the user identifier is associated with a serial number that, at least in part, is assigned to the SIM by a manufacturer of the SIM. (Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 5, Peck teaches a communication device (Fig. 1 [24] and Fig. 2) that has a processor (Fig. 2 [68]) configured to encrypt at least one of the device identifier and the user identifier before transmission to the communication network. (Col. 2 lines 12-61 and Col. 7 lines 36-49)

Regarding claim 6, Peck teaches a processor (Fig. 2 [68]) and a user input interface configured to supply commands to the processor. (Fig. 2 [76])

Regarding claim 7, Peck teaches a cell phone comprising a display (Fig. 2 [78]) configured to display data and commands (Col. 6 lines 25-34), a user input interface for data entry and command entry (Fig. 2 [76]), a SIM (Fig. 2 [90]) having a SIM serial number (Col. 2 lines 49-61 and Col. 3 lines 51-57) that, at least in part, is assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") and a

transmitter configured to transmit the SIM serial number to a network. (Fig. 2 [54], Col. 7 lines 36-49 and Col. 10 lines 20-25)

Regarding claim 8, Peck teaches a cell phone (Fig. 2), comprising memory (Fig. 2 [86]) configured to store a device identifier (Col. 3 lines 51-57 and Col. 5 lines 18-21), wherein the transmitter is configured to transmit the device identifier. (Col. 7 lines 36-49)

Regarding claim 27, Peck teaches a register configured to store a mobile station number and the transmitter is configured to transmit the mobile station number and the user identifier to a network. (Col. 1 lines 33-54, Col. 3 lines 9-15 and Col. 10 lines 5 & 20-25)

Regarding claim 28, Peck teaches a mobile station number is a mobile station phone number which is the same as the MSISDN number. (Col. 1 lines 33-54)

Regarding claim 30, Peck teaches a register configured to store a mobile subscriber identity and the transmitter is configured to transmit the mobile subscriber identity to the network. (Col. 2 lines 30-61)

Regarding claim 31, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI). (Col. 2 lines 30-48)

Regarding claim 32, Peck teaches the register is configured to store a mobile subscriber identity and the transmitter is configured to transmit the mobile subscriber identity to the network. (Col. 1 lines 33-54)

Regarding claim 33, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI). (Col. 2 lines 30-48)

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 10, 11, 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. (US-6,310,889 hereafter, Parsons) in view of Peck.

Regarding claim 10, Parsons teaches a content provider configured to communicate with one or more mobile stations (Col. 1 line 54 through Col. 2 line 32), comprising a content personalization interface configured to receive an user identifier from at least one of the mobile stations. (Col. 8 lines 56-61) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not explicitly reciting the user identifier is based on a SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as a user identifier. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable,

switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Regarding claim 11, Parsons in view of Peck teaches a processor configured to deliver content to the at least one mobile station based on the anonymous user identifier. (Parsons Col. 8 lines 56-61, Peck Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 14, Parsons teaches a content provider comprising a personalization interface configured to receive personalization data that is a user identifier and a processor configured to provide content to a user based on the personalization data. (Col. 2 lines 11-32 and Col. 8 lines 56-61) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not mentioning the user identifier is based on a SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as a user identifier. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable, switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Regarding claim 15, Parsons in view of Peck teaches a database configured to store personalization data. (Parsons Col. 4 lines 35-45)

Regarding claim 16, Parsons in view of Peck teaches the personalization interface is configured to receive personalization data associated with an HTTP header. (Parsons Col. 4 line 66 through Col. 5 line 50)

Regarding claim 17, Parsons in view of Peck teaches a personalization interface configured to receive anonymous personalization data that includes a device identifier and the processor provides device-specific content based on the device identifier. (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 18, Parsons in view of Peck teaches a personalization interface configured to receive anonymous personalization data from a mobile station. (Parsons Col. 8 line 56 through Col. 9 line 56, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 19, Parsons in view of Peck teaches the personalization interface is configured to receive the user identifier that is stored on the SIM. (Peck Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 20, Parsons in view of Peck teaches the user identifier is the SIM serial number (Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) assigned by the manufacturer of the SIM. (Peck Col. 8 lines 50-52 “the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer”)

Regarding claim 21, Parsons teaches a method of providing personalized content in a wireless communication by selecting a user identifier and selecting content based on the user identifier. (Col. 1 line 59 through Col. 2 line 32) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not mentioning the user identifier is based on a SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as a user identifier. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable, switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Regarding claim 22, Parsons in view of Peck teaches the user identifier selected based on the serial number of the SIM card. (Peck Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 23, Parsons in view of Peck teaches selecting a device identifier. (Peck Col. 2 lines 12-61 and Col. 7 lines 36-49)

Regarding claim 24, Parsons in view of Peck teaches comparing the device identifier and the user identifier with a set of user profiles and selecting content based on a selected user profile. (Peck Col. 2 lines 12-61, Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 25, Parsons in view of Peck teaches a method of anonymous personalized content by selecting an anonymous user identifier based, at least in part, on a serial number assigned by a SIM manufacturer to a subscriber identification module (Peck Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") and identifying content for delivery based on the anonymous user identifier. (Parsons Col. 1 line 59 through Col. 2 line 32)

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS  
8/28/2007

  
LESTER G. KINCAID  
SUPERVISORY PRIMARY EXAMINER